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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Steven H. Kong, et al

THERMALLY DEVELOPABLE
IMAGING MATERIALS HAVING
BACKSIDE STABILIZERS

Serial No. 10/685,858

Filed 15 October 2003

Group Art Unit: 1752

Examiner: CHEA, Thorl

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Sherryl A. Payne
Sherryl A. Payne

June 16, 2005
Date

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

DECLARATION UNDER 37 C.F.R. 1.132

I, Steven H. Kong, declare that:

(1) I am a co-inventor of the invention described and claimed in the present application, along with Kumars Sakizadeh.

(2) I received a Ph.D. degree in physics from the University of Illinois in 1992. In the course of my graduate studies, I was the author or co-author of 4 publications during that research that were published during 1985 to 1994. In addition, I carried out undergraduate research at the California Institute of Technology from 1981 to 1985.

(3) From May 1995 to July 1996, I was employed by 3M Company; from July 1996 to December 1998, I was employed by Imation Corporation; and from December 1998 to the present, I have been employed by Eastman Kodak Company, all in facilities located near St. Paul, Minnesota.

(4) During my employment with 3M Company, Imation Corporation, and Eastman Kodak Company, I have been involved in research and development work in the area of imaging science and materials, and particularly in the research and development of photothermographic materials and components thereof including stabilizers and antifoggant compounds. In the course of that work, I have been an inventor or co-inventor of at least 12 inventions, all of which are the subject of granted U.S. patents, pending U.S. patent applications, or published patent applications in other countries.

(5) In view of this considerable academic and professional technical experience, I can say, with appropriate modesty, that I am a worker having at least ordinary skill in the art to which the present invention pertains, namely the use of certain nitrogen-containing aromatic compounds as backside shelf life stabilizers in the preparation of photothermographic materials.

(6) I am familiar with the Office Action mailed February 23, 2005 in the prosecution of the present application, the rejections and art cited therein, and I believe that I understand the Examiner's arguments in support of his rejections of the presently claimed invention.

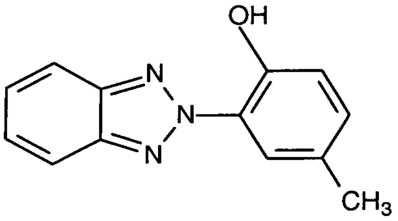
(7) It is my opinion, not only as a co-inventor but also as one having at least ordinary skill in the art to which the present invention pertains, that the unpatentability rejections are incorrect, particularly as they are based on the teaching in EP 1 186 950 alone (of which I am a co-inventor), EP '950 in combination with U.S. Patent 4,212,937 (Akashi et al.) and EP 1 096 310 (EP '310), or in the claims of U.S. Patent 6,465,162 (Kong et al.) of which I am the lead patentee. Kong et al. and EP '950 are counterparts describing and claiming the same invention.

(8) It is my opinion that the presently claimed invention is not taught or suggested by EP '950, alone or in combination with Akashi et al. and EP '310, because the compounds of Structure V in that reference do not teach or suggest the compounds within Structure II of the presently claimed invention. In addition, the cited claims of Kong et al. fail to teach or suggest the presently claimed invention for the same reasons.

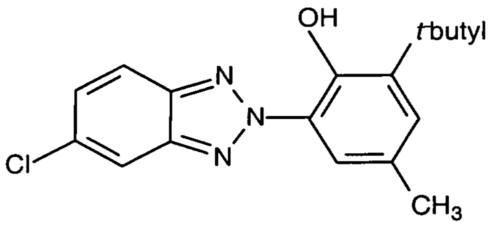
(9) As further evidence of patentability of the presently claimed invention, I made and evaluated Comparative backside coating samples using two compounds within Structure V of EP '950 and the cited claims of Kong et al.

The Comparative backside coating samples were prepared and evaluated essentially the same way the inventive backside coating samples were prepared and evaluated on pages 71-73 of the present application. Moreover, the data I obtained using the Comparative backside coating samples are to be compared to data shown in TABLE I on pages 73-75.

More particularly, I tested the following Comparative Compounds A and B to see if they would provide shelf stability in Comparative Backside Coating Samples A and B. These Comparative compounds are benzotriazoles having phenyl group substituents at the 2-nitrogen position and are within Structure V of Kong et al. and EP '950. They are similar in structure to Compounds NCH-28 and NCH-29 used in the presently claimed invention but yet Compounds A and B are outside of the presently claimed invention. In particular, they are not within our Structure II.



Compound A



Compound B

After coating and evaluating the Comparative Backside Coating Samples A and B as described on page 73 of the present application, I determined the following ΔD_{min} values that are indicative of stabilization (or lack thereof) of the photothermographic material to "shelf-aging fog". These data obtained are to be compared to data shown in TABLE I on pages 73-75. In particular, the ΔD_{min} values obtained using inventive Compounds NCH-28 and NCH-29 is to be compared to the ΔD_{min} values obtained using Comparative Compounds A and B, as shown in the following TABLE. The more negative the values, the better the stabilizing effect of the heterocyclic compounds in the backside coating samples.

Compound	Level	Aging Conditions	ΔD_{min}
NCH-28	1.5	70°F (21°C) at 95% RH	-50%
NCH-29	1.5	70°F (21°C) at 95% RH	-40%
Comparative A	1.5	70°F (21°C) at 95% RH	-17%
Comparative B	1.5	70°F (21°C) at 95% RH	+10%

These data indicate that compounds within the scope of Structure V of Kong et al. and EP '950 were generally poor backside stabilizers and in fact, in the case of Comparative Compound B, the shelf-aging fog became worse. The similarly structured compounds within the scope of the presently claimed invention, however, were significantly better in solving the shelf-aging fog problem. I believe that these results are not predictable from any teaching in the cited references, and in particular from the teaching of EP '950 and the claims of Kong et al.

(10) That all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true. These statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: 6/10/05

Steven Kong

Steven H. Kong